

§ § §

REMARKS

In order to promote administrative efficiency and better communication, the Examiner is invited to make suggestions at any time during the proceedings, via phone, fax or e-mail, whenever such suggestions are within the Examiner's discretion as an aid to placing the claims in order for allowance in a timely manner.

Support of the amendments may be found in US'417, incorporated by reference in the pending application. No new matter is entered thereby.

Points 1 & 6: §103(a) Rejection based on Germann ('417) in view of Cushner et al ('353) as well as other references:

The Examiner rejected claims 9-11, 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over Germann (US Patent No. 5,282,417) in view of Cushner, stating *inter alia*, that it would be obvious to modify the inking plate of Germann such that the inking plate is formed of at least a base plate having an outer major surface to be directed away from the central area and polymer material defining an outer layer of deposited material which is deposited directly or indirectly on said base plate over a majority of the outer surface of the base plate, and wherein exclusively the outer layer of the inking plate is cut so as to define ink transporting relief surfaces having limits corresponding to the outlines of surfaces to be inked on the plate cylinder because Cushner teaches that such inking plates are easier and faster to manufacture than prior art plates. Applicant traverses this rejection asserting that it is clearly not obvious to use the flexographic printing plates disclosed in US 5,804,353 to replace the inking plates known from US 5,282,417. As already mentioned in the previous official response, flexographic plates described in US 5,804,353 are in fact printing plates. There is no indication or suggestion in US'353 that these printing plates can or could be used for inking. Consequently, the combination of the teaching of these two prior art references is a pure *ex post facto* analysis made in light of Applicant's written disclosure. The Applicant respectfully submits that the Examiner has therefore been engaging in impermissible hindsight reconstruction of the invention, and only in that way is he able to subjectively state that applicant's invention is an obvious combination of Germann and Cushner and/or

in further view of Fan and Recchia, such being contrary to the opinions of the Federal Circuit. Applicant offers the following quotes from the Federal Circuit, which indicate that the examiner's position is incorrect:

«When determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.»¹ «The Commissioner bears the burden of showing that such knowledge provided some teaching, suggestion, or motivation to make the particular combination that was made by the applicant.»²

«Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination. . . . It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.»³

«Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103

¹ *In re Beattie*, No. 91-1396, slip op. at 7 (Fed. Cir. Sept. 4, 1992) (affirming the rejection of claims to a diatonic/chromatic scale marker intended to rest on the keys of a piano as unpatentable under 35 U.S.C. § 103 (1988)) (quoting *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)).

² *In re Raynes*, No. 92-1292, slip op. at 3 (Fed. Cir. October 26, 1993) (affirming the board's decision holding all claims of a patent application for a computer-processed interactive automobile service station unpatentable for failure to meet the requirements of 35 U.S.C. § 103) (citing *In re Oetiker*, 977 F.2d 1443, 1445-47, 24 USPQ2d 1443, 1444-46 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 788 (Fed. Cir. 1984)).

³ *In re Gorman*, No. 90-1362, slip op. at 7 (Fed. Cir. May 13, 1991) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and affirming the Board's finding that a molded candy on a stick was obvious); *In re Fritch*, No. 91-1318, slip op. at 12 (Fed. Cir. Aug. 11, 1992) (reversing the Board's rejection of landscape edging as obvious).

requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. *Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.*⁴

As Examiner is aware, a person of ordinary skill in the art is presumed to be one who thinks along the lines of conventional wisdom in the art and is not one who undertakes to innovate, whether by extraordinary insights or by patient and often expensive systematic research. *See Loctite Corp. v. American Cyanamid Co.*, 774 F.2d 448 (Fed. Cir. 1985). Conventional wisdom dictates that flexographic plates (not flexoplates), are used for flexographic printing, in which the ink is received on the high surfaces of the etched plate, not in the recesses. Further, the flexographic impression plate of Cushner is a plate that carries the impression pattern and which is applied directly on the substrates to be printed in order to perform the printing operation. In contrast, an inking plate as defined in the claimed rotary printing machine does not as such carry an impression pattern and is solely used to perform an inking operation. The problem solved by the invention is therefore different in that the inking plate is used for inking the plate cylinder of the printing machine, either directly or indirectly, while the plate cylinder does the printing on the substrates. The plates described in the cited reference do not have the same application and thus do not teach or suggest to one of ordinary skill that such a printing plate may be used for the inking. In other words, one of ordinary skill would rather tend to apply the teaching of Cushner to the printing plates of Germann, rather than to the inking plates.

As for the other cited references, none describes an inking plate having the claimed characteristics and thus do not teach or suggest the printing machine as now claimed.

⁴ *In re Vaeck*, No. 91-1120, slip op. at 10 (Fed. Cir. Oct. 21, 1991) (reversing the PTO Board's affirmance of the examiner's rejection of certain claims under § 103, and citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988)).

Because there is no nexus of the type of printing, the combination is inappropriate, absent an express motivation.

Examiner's Point 8:

In point 8 of the Final Rejection, the Examiner suggests that a structural formulation could be distinguished over the prior art. On this point, we wish to point out once again that the claimed machine structurally differs from the configuration disclosed in US'353 in that the presently claimed inking plate inks directly or indirectly plate cylinder and thus does not contact the substrate to be printed. On the contrary, in the '353 patent, the described plates are printing plates that are brought in direct contact with the substrate to be printed. Hence, it is not only the function of the plates that changes but also their position in the machine. Therefore, it is asserted that the claiming of a printing machine and not only an inking cylinder with its plate, provides the requisite structural differentiation.

Regarding Claim 9:

Further, the claims more than adequately distinguish the machine from prior art machines in that claim 9 is already limited by the inking plate wherein exclusively the outer layer of the inking plate is cut so as to define *ink transporting relief surfaces* having limits corresponding to the outlines of surfaces to be inked on the plate cylinder. As suggested by the Examiner under his point 8, this is a structural feature specific to intaglio plates and absent from flexographic plates. Consequently, it is believed that the claim as originally presented, is patentable over the prior art. The further amendments to the claim are therefore not made to limit the claim but merely to clarify the claim further such that the Examiner is able to appreciate the pre-existing limitation to intaglio printing. For example, in order to more positively recite this limitation, the last "wherein phrase" of claim 1 has been amended to require that "wherein the inking plate includes ink transporting relief surfaces exclusively in the outer layer, the surfaces having limits corresponding to the outlines of surfaces to be inked on the plate cylinder." This is a significant structural difference because special treatment of the surface is required for a plate to have the desired

oilofilic/hydrophobic characteristics necessary and well-known in order to accomplish intaglio printing.

The Examiner mentions that Germann teaches that the inking cylinder 10 can preferably carry plates consisting of a somewhat elastic material, so called flexoplates, which are suitable for both direct and indirect inking. However, it should be emphasized that the expression "flexoplates" used in the '417 for defining the inking plates should not be understood as a reference to flexographic printing plates. The expression "flexoplates" is only directed to a plate formed of an elastic material. The similarity with flexographic printing plates ends there.

Regarding claims 10-18

Applicant appreciates the diligent review of this case, including the combinations made by the Examiner to reject the above claims were based on the Examiner's assertion that claim 9 is not patentable. It is believed however that Applicant has clearly pointed out why claim 9 is indeed patentable and therefore, all dependent claims therefrom should also by definition be themselves patentable. Acknowledgment of this fact is respectfully requested.

Request for an Interview

In this After Final case, Applicant believes that any open issues can be resolved via telephonic interview and therefore will contact the Examiner to arrange the same. Applicant's representative practices in Switzerland, which is 6 hours ahead of EST. Therefore, the most convenient time of the day for the Undersigned is anytime between 8AM and 12PM, EST.

§ § §

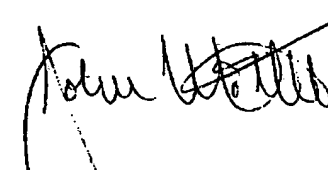
Conclusion

Applicant has made a diligent effort to advance the prosecution of this application by amending the claims and including remarks which show how the claims are patentably distinct from the prior art of record. Therefore, Applicant respectfully

submits that the claims, as previously presented, and more clearly as now amended, are now in condition for allowance. No new matter has been entered by this amendment. Any limitations to the claims are made solely for the purpose of expediting the prosecution of the application and, unless otherwise expressly stated, are not made to narrow, vis-à-vis the prior art, the scope of protection which any subsequently issuing patent might afford. Again, if the Examiner has further questions, he is invited to contact the undersigned at phone 011-4122-747-7849, fax at 011-4122-346-8960 (Geneva is 6 hours ahead of Eastern STD Time), or e-mail at patents@bugnion.ch.

Applicant petitions the Commissioner for an Extension of Time under 37 CFR §1.136 for a period of 0 months and the Undersigned authorizes the Commissioner to charge any fee or credit any overpayment of any fee under 37 CFR §1.16 and §1.17 which may be required in this application to the deposit account of BUGNION S.A., no. 50-0800.

Respectfully submitted,



John MOETTELI
Registration No 35,289
c/o BUGNION S.A.
10, route de Florissant
P.O. Box 375
1211 GENEVE 12
SWITZERLAND

Date: July 20, 2005